

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY N. EISEN

Appeal 2007-2514
Application 10/034,255
Technology Center 2100

Decided: September 21, 2007

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and ST. JOHN
COURTENAY, III, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Eisen (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 25, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a method for enabling a user to select documents from a summary view of documents and to create a list of the

selected documents. See generally Specification 1:10-12. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A computer-implemented method, comprising the steps of:
 - displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document;
 - enabling a user to select one or more of the entries listed in the summary view;
 - receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard;
 - creating the reusable list of the selected entries and storing the reusable list in the system clipboard in response to the input received from the user, wherein
 - for each of the one or more selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry, and a hyperlink to the document associated with the selected entry, not a copy of the document, and wherein the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view; and
 - in response to the user selecting a hyperlink from the reusable list, displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Huang US 2003/0097361 A1 May 22, 2003

Kate Barnes, *10 Minute Guide to Windows 3.1*, Sams, 1992, pp. 60-64.
(Barnes)

Outlook 97 editing screen dumps, Microsoft Corp., 1996, pp. 1-5.
(Outlook 97)

Outlook 2000 sp-3 copy and paste screen dumps, Microsoft Corp., 1999,
pp. 1-3. (Outlook 2000)

Claims 1 through 25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Huang in view of Barnes, Outlook 2000, and Outlook 97.

We refer to the Examiner's Answer (mailed March 7, 2007) and to Appellant's Brief (filed November 14, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse both the indefiniteness rejection and also the obviousness rejection of claims 1 through 25.

OPINION

The Examiner asserts (Answer 3) that claims 1 through 25 are indefinite because of the language "the list can be" in independent claim 23 and "the list is able" in the remaining independent claims. The Examiner asserts that "[t]he cited language introduces ambiguity into the claims, since it implies that a step may or may not be carried out." Appellant contends (Br. 8-9) that the language in question describes a feature of the list, not a step of the method. Further, the phrases "have a readily discernable plain meaning, and are described in detail in the Specification" (see Br. 9). Thus,

the first issue is whether the language "the list can be" and "the list is able" renders the claims indefinite.

As pointed out by Appellant (Br. 8-9), the language in question describes a characteristic of the list, the ability to be pasted into another document. The language does not imply an additional step to the method. Further, the plain meaning of the language is clear. Therefore, we cannot sustain the rejection of claims 1 through 25 under 35 U.S.C. § 112, second paragraph.

Appellant contends (Br. 10) that the Examiner's rationale for combining the references contradicts the claimed invention and, therefore, is improper. Specifically, the Examiner asserts (Answer 4) that it would have been obvious to copy a list from email to the clipboard because Barnes teaches that copying data to the clipboard protects and preserves the original files attached to the email so that the user can use those files without damaging the original files. Appellant contends (Br. 10) that preserving the original file is in direct contrast to the claimed "displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list," which appears in each of independent claims 1, 8, 15, 23, and 24. One issue, therefore, is whether the Examiner's rationale for copying the reusable list to the clipboard contradicts the claimed invention.

Appellant further contends (Br. 11) that the combination of references fails to teach or suggest all of the claimed elements. In particular, Appellant contends (Br. 11) that the combination lacks creating the reusable list and storing it in the system clipboard, as recited in each of independent claims 1, 8, 15, 23, and 24. Lastly, Appellant contends (Br. 13) that the combination

of references fails to teach or suggest including a hyperlink for each entry in the reusable list, as recited in each of independent claims 1, 8, 15, 23, and 24. Thus, another issue is whether the Examiner's proposed combination of references includes all elements of the claimed invention.

The Examiner (Answer 4) admits that "Huang fails to explicitly disclose: *receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard in response to the input received from the user.*" The Examiner asserts (Answer 4) that Outlook 2000 teaches creating a reusable list by copying selected email entries. Then the Examiner states (Answer 4) that Barnes teaches copying information to a clipboard to avoid disturbing the original.

Assuming that the combination of Huang and Outlook 2000 provides for creating a reusable list of selected entries, we find no reason why the skilled artisan would copy that list to a system clipboard. Barnes discloses (Barnes 60) that in Windows, cutting information removes the information from its original location and places it on the clipboard, whereas copying information leaves the original alone and places a copy on the clipboard. Thus, Barnes does not suggest using a clipboard to protect the original, but rather teaches that copying rather than cutting preserves the original. Nonetheless, even if the Barnes disclosure could be read as teaching that copying to a clipboard leaves the original document undisturbed, the claimed invention (for each independent claim) requires including a hyperlink with each entry so as to link to "a current version of a document associated with the hyperlink." Thus, the claimed invention allows original documents to be modified, which seems to conflict with the Examiner's reasoning of letting the original documents remain undisturbed.

In addition, the Examiner (Answer 5) relies upon Outlook 97 for a suggestion of using a hyperlink to a current version of a document associated with the hyperlink. However, Outlook 97 merely shows opening an email message in another window. We find no suggestion to include a hyperlink with each entry of a reusable list to link to the current version of the document associated with the hyperlink. Thus, the Examiner has not established a prima facie case of obviousness for each of independent claims 1, 8, 15, 23, and 24, nor for their dependents, claims 2 through 7, 9 through 14, 16 through 22, and 25. Consequently, we cannot sustain the obviousness rejection of claims 1 through 25.

ORDER

The decision of the Examiner rejecting claims 1 through 25 under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103 is reversed.

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REVERSED

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